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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,744	08/24/2001	Yumin Mao	34606PCTUSAA; 072975.0111	4091
21003	7590	02/25/2004	EXAMINER	
BAKER & BOTTS 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			WHISENANT, ETHAN C	
			ART UNIT	PAPER NUMBER
			1634	

DATE MAILED: 02/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/938,744

Applicant(s)

MAO ET AL.

Examiner

Ethan Whisenant, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12 and 14 is/are rejected.
- 7) ☒ Claim(s) 11, 13 and 15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 AUG 01 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>13 NOV 03</u> . | 6) <input type="checkbox"/> Other: _____ |

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FINAL REJECTION

1. The applicant's Response (filed 13 NOV 03) to the Office Action has been entered. Following the entry of the claim amendment(s), **Claim(s) 1-15** is/are pending. Rejections and/or objections not reiterated from the previous office action are hereby withdrawn. The following rejections and/or objections are either newly applied or reiterated. They constitute the complete set presently being applied to the instant application.

35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligations under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

CLAIM REJECTIONS UNDER 35 USC § 103

4. The rejection of **Claim(s) 1-10, 12, and 14** under 35 U.S.C. 103(a) as being unpatentable over Soares et al. [US 5,482,845 (1996)] in view of Adams et al. [Nature (SEP 1995)] is maintained.

RESPONSE TO APPLICANT'S AMENDMENT AND/OR ARGUMENTS

5. Applicant's arguments have been fully and carefully considered but they are not deemed to be persuasive. To begin the applicant explains what the examiner's burden to establish a case of *prima facie* obviousness and direct the examiner's attention to the MPEP at 2142 and 2143.03. Next, the applicant asserts that the examiner has not demonstrated how either Soares et al. or Adams et al. teach or suggest either "homogenizing the cDNA original library according to a graded Cot value" or "hybridizing and subtracting the homogenized cDNA library with said probes" as recited in claim 1.

In response, the examiner recognizes his burden and has reviewed MPEP at 2142 - 2143.03. As regards the applicant's assertion that the examiner has not demonstrated how either Soares et al. or Adams et al. teach or suggest "homogenizing the cDNA original library according to a graded Cot value" as recited in claim 1. The examiner continues to assert that Soares et al. and/or Adams et al. teach these limitations.

Soares et al. teaches homogenizing the cDNA original library according to a graded Cot value, see at least for example, Column 4 This invention provides a method to normalize a directional cDNA library constructed in a vector that allows propagation in single-stranded circle form comprising: (a) propagating the directional cDNA library in single-stranded circles; (b) generating fragments complementary to the 3' noncoding sequence of the single-stranded circles in the library to produce partial duplexes; (c) purifying the partial duplexes; (d) melting and reassociating the purified partial duplexes to moderate Cot; and (e) purifying the unassociated single-stranded circles, thereby generating a normalized cDNA library. Is not moderate Cot "a graded Cot value"? The examiner asserts that it is.

As regards, the applicant's assertion that the examiner has not demonstrated how either Soares et al. or Adams et al. teach or suggest "hybridizing and subtracting the homogenized cDNA library with said probes" as recited in claim 1. The applicant's attention is directed to, at least for example, the first paragraph in the first column of page 6 wherein Adams et al. teaches "Several cDNA libraries contained

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one or more extremely abundant species (more than 5% of the sequenced clones). In these cases, the individual abundant cDNAs or total cDNA was labelled and used as a probe to screen gridded arrays of clones from the library. Non-hybridizing clones were chosen for sequencing. In the examiner's opinion, this teaching constitutes "hybridizing and subtracting the homogenized cDNA library with said probes". The key word here appears to be "subtracting". The applicant appears to be asserting that "subtracting" means that the library itself must be altered in some way. In response, the examiner suggests that the applicant recite in the claim what ever additional limitations that the word "subtracting" brings to the claim. Without these additional limitations, the examiner asserts that Adams et al. teach "hybridizing and subtracting the homogenized cDNA library with said probes". Please note that "while the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. *In re Van Guens*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Finally, please note Lockhart et al. who teach/claim a method of selecting clones for analysis which is very similar to that taught in the first paragraph of the first column of page 6 of Adams et al.

CLAIM OBJECTIONS

- 6.** Claim(s) 11, 13 and 15 are objected to because they are dependent upon a rejected independent base claim.

CONCLUSION

- 7.** Claim(s) 1-15 is/are rejected and/or objected to for the reason(s) set forth above.

- 8. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ethan Whisenant, Ph.D. whose telephone number is (571) 272-0754. The examiner can normally be reached Monday-Friday from 8:30AM -5:30PM EST or any time via voice mail. If repeated attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion, can be reached at (571) 272-0782.

The fax number for this Examiner is (571) 273-0754. Before faxing any papers please inform the examiner to avoid lost papers. Please note that the faxing of papers must conform with the Notice to Comply published in the Official Gazette, 1096 OG 30 (November 15, 1989).



**ETHAN WHISENANT
PRIMARY EXAMINER**

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